

REMARKS

In the Office Action¹, the Examiner took the following actions:

rejected claims 11-13, 15, and 17-19 under 35 U.S.C. § 112 as being indefinite;

rejected claims 4, 16-17, and 19-20 under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Patent no. 7,246,058 B2 to Burnett ("*Burnett*");

rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Patent no. 5,853,005 to Scanlon ("*Scanlon*");

rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over *Burnett* in view of U.S. Pat no. 4,654,883 to Iwata ("*Iwata*"); and

rejected claims 5-15 under 35 U.S.C. § 103(a) as being unpatentable over *Burnett* in view of U.S. Pat no. 5,729,694 to Holzrichter et al. ("*Holzrichter*").

By the present amendment Applicant has cancelled claim 18 without prejudice or disclaimer and amended claims 10-13, 15, 17, and 19-20 to more appropriately define the invention. Claims 2-17 and 19-20 remain pending, and the rejections of claim 18 are rendered moot by the cancellation.

I. Rejection of claims 11-13, 15, 17, and 19 under 35 U.S.C. §112, second paragraph

The Examiner rejected claims 11-13, 15, and 17-19 under 35 U.S.C. § 112 alleging that it "is unclear to examiner how does a person generate non-audible sounds such as sub-sonic and ultra-sonic." Office Action, page 3. Applicant respectfully traverses this rejection. The Examiner considers "non-audible sounds" as "sub-sonic

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

and ultra-sonic” sounds. However, the Examiner’s interpretation is not correct because “non-audible sounds” may be low-powered sounds such as a non-audible murmur not involving regular vibrations.

Moreover, to advance prosecution Applicant has amended claims 11-13, 15, and 17-19 to recite for example, “sampling sounds generated by a first person which are non-audible to a second person,” thus even more clearly defining the invention. Accordingly, Applicant submits that claims 11-13, 15, and 17-19 fully meet the requirements of 35 U.S.C. § 112 and respectfully requests the Examiner to reconsider and withdraw the rejection of claims 11-13, 15, and 17-19 under 35 U.S.C. §112.

II. Rejection of claims 4, 16-17, and 19-20 under 35 U.S.C. § 103(a) as being unpatentable in view of *Burnett*

Applicant respectfully traverses the rejection of claims 4, 16-17, and 19-20 under 35 U.S.C. § 103(a) as being unpatentable in view of *Burnett*. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P. § 2145*. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and

the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P.* § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103(a) is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966) . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the difference between the claimed invention and the prior art.” *M.P.E.P.* § 2141(II). Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P.* § 2141(III).

Independent claim 17 recites a device for sampling sounds including “a positioning structure coupled to the microphone, the positioning structure positioning the microphone on a surface of skin over a sternocleidomastoid muscle below a mastoid of the first person so as to detect vibrations non-audible to the second person, which are transmitted through flesh of the first person to the sternocleidomastoid muscle and conducted through the skin” (emphasis added). *Burnett* does not teach at least these elements of claim 17, and does not render claim 17 obvious.

The Examiner correctly states that “*Burnett* does not explicitly teach the positioning structure positioning the microphone on a surface of skin over a sternocleidomastoid muscle below a mastoid of the person.” However, the Examiner alleges that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modified [*sic*] the invention of *Burnett* by implementing a

particular arrangement (such as, the positioning structure positioning the microphone on a surface of skin over a sternocleidomastoid muscle below a mastoid of the person) as claimed.” Office Action, page 4. However, this allegation is not correct.

Burnett discloses “[p]lacing the microphones Mic 1 and Mic 2 in a linear array with the mouth on the array midline,” (Figure 7, column 7, lines 53-55) where “[t]he sensor detects human tissue motion associated with the closure of the vocal folds, so the acoustic signal produced by the closure of the folds is highly correlated with the closures,” (column 5, lines 26-29). Thus, the sensor taught by *Burnett* is placed in a linear array with the mouth to detect acoustic signals produced by vocal folds. However, detecting acoustic signal produced by vocal folds does not constitute “to detect vibrations non-audible to the second person, which are transmitted through flesh of the first person to the sternocleidomastoid muscle and conducted through the skin,” (emphasis added) as recited in claim 17, because the sensor in *Burnett* does detect non-audible vibrations “transmitted through flesh of the first person to the sternocleidomastoid muscle.”

The Examiner cites to column 5, lines 15-25 of *Burnett* and alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Burnett* by placing a sensor over a sternocleidomastoid muscle. However, *Burnett* teaches away from such a modification. In column 5, lines 16-21 *Burnett* states “there are sensor locations (such as the jaw or back of the neck) where speech production can be detected but where the signal may have incorrect or distorted time-based information. That is, they may not have well defined features in time that will match with the acoustic waveform” (emphasis added).

Thus, the sensor in *Burnett* does not “detect vibrations non-audible to the second person, which are transmitted through flesh of the first person to the sternocleidomastoid muscle,” as recited in claim 17. Moreover, it would not have been obvious to one of ordinary skill in the art to modify the invention of *Burnett*, because one of ordinary skill in the art would recognize that *Burnett* teaches away from “a positioning structure coupled to the microphone, the positioning structure positioning the microphone on a surface of skin over a sternocleidomastoid muscle below a mastoid of the first person so as to detect vibrations non-audible to the second person, which are transmitted through flesh of the first person to the sternocleidomastoid muscle and conducted through the skin and conducted through the skin,” (emphasis added) as recited in claim 1.

As discussed, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P.* § 2141.02(I), internal citations omitted (emphasis in original).

Here, no *prima facie* case of obviousness has been established for at least the reason that, in view of the failure of *Burnett* to teach the claimed combination, as discussed above, the Office Action has not properly determined the scope and content of the *Burnett* and has accordingly not properly ascertained the difference between *Burnett* and the matter of claim 17. Regarding the differences that have been cited, no reason has been provided as to why one of ordinary skill in the art, at the time the invention was made, would modify *Burnett*. Moreover, the Office Action has not

identified any predictability or reasonable expectation of success of such a modification.

Furthermore, *Burnett* teaches away from the claimed combination.

For at least these reasons, the Office Action has failed to clearly articulate a reason why *Burnett* would render the claimed combination obvious to one of ordinary skill in the art. Thus no *prima facie* case of obviousness has been established with respect to claim 17. Claims 4, 16, and 20 depend from claim 17 and are thus also allowable over *Burnett*, for at least the same reasons as claim 17.

Independent claim 19, though of different scope from claim 17, recites elements similar to those of claim 17 and is thus also allowable over *Burnett* for reasons similar to those presented above for claim 17. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

III. Rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable in view of *Scanlon*

As noted above the cancellation of claim 18 renders moot its rejection under 35 U.S.C. § 103(a).

IV. Rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over *Burnett* in view of *Iwata*

Applicant respectfully traverses the rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over *Burnett* in view of *Iwata*. A *prima facie* case of obviousness has not been established.

Claims 2 and 3 depend from claim 17 and thus require all elements of claim 17. As set forth above *Burnett* does not disclose each and every element recited in claim 17 and required by claims 2 and 3. *Iwata* fails to remedy the above-noted deficiencies of *Burnett* with respect to independent claim 17. For example, *Iwata* fails to teach,

suggest, or render obvious among other things a method including “a positioning structure coupled to the microphone, the positioning structure positioning the microphone on a surface of skin over a sternocleidomastoid muscle below a mastoid of the first person so as to detect vibrations non-audible to the second person, which are transmitted through flesh of the first person to the sternocleidomastoid muscle and conducted through the skin” (emphasis added) as recited in claim 17 and required by claims 2 and 3.

Here, no *prima facie* case of obviousness has been established for at least the reason that, in view of the failure of the references to teach the claimed combination, as discussed above, the Office Action has not properly determined the scope and content of the references and has accordingly not properly ascertained the difference between the references and the matter of claim 17. Regarding the differences that have been cited, no reason has been provided as to why one of ordinary skill in the art, at the time the invention was made, would modify *Burnett* or *Iwata*. Moreover, the Office Action has not identified any predictability or reasonable expectation of success of such a modification.

For this reason, the Office Action has failed to clearly articulate a reason why *Burnett* and *Iwata* would render the claimed combination obvious to one of ordinary skill in the art. Thus no *prima facie* case of obviousness has been established with respect to claims 2 and 3.

Accordingly, for at least the above-noted reasons, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 2 and 3.

V. Rejection of claims 5-15 under 35 U.S.C. § 103(a) as being unpatentable over *Burnett* in view of *Holzrichter*

Applicant respectfully traverses the rejection of claims 5-15 under 35 U.S.C. § 103(a) as being unpatentable over *Burnett* in view of *Holzrichter*. A *prima facie* case of obviousness has not been established.

Claims 5-15 depend from claim 17 and thus require all elements of claim 17. As set forth above *Burnett* does not disclose each and every element recited in claim 17 and required by claims 5-15. *Holzrichter* fails to remedy the above-noted deficiencies of *Burnett* with respect to independent claim 17. For example, *Holzrichter* fails to teach, suggest, or render obvious among other things a method including “a positioning structure coupled to the microphone, the positioning structure positioning the microphone on a surface of skin over a sternocleidomastoid muscle below a mastoid of the first person so as to detect vibrations non-audible to the second person, which are transmitted through flesh of the first person to the sternocleidomastoid muscle and conducted through the skin” (emphasis added) as recited in claim 17 and required by claims 5-15.

Here, no *prima facie* case of obviousness has been established for at least the reason that, in view of the failure of the references to teach the claimed combination, as discussed above, the Office Action has not properly determined the scope and content of references and has accordingly not properly ascertained the difference between the references and the matter of claim 17. Regarding the differences that have been cited, no reason has been provided as to why one of ordinary skill in the art, at the time the invention was made, would modify *Burnett* or *Holzrichter*. Moreover, the Office Action

has not identified any predictability or reasonable expectation of success of such a modification.

For this reason, the Office Action has failed to clearly articulate a reason why *Burnett* and *Holzrichter* would render the claimed combination obvious to one of ordinary skill in the art. Thus no *prima facie* case of obviousness has been established with respect to claims 5-15.

Accordingly, for at least the above-noted reasons, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 5-15.

CONCLUSION

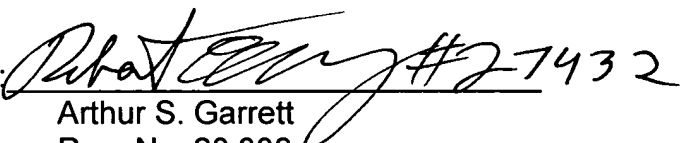

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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